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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 09/870,119 | 05/30/2001 | Sharon Ehrlich | 71423 | 6524 |
| 22242 | 7590 | 01/04/2005 | EXAMINER | |
| FITCH EVEN TABIN AND FLANNERY | | | CRAIG, DWIN M | |
| 120 SOUTH LA SALLE STREET | | | ART UNIT | PAPER NUMBER |
| SUITE 1600 | | | | |
| CHICAGO, IL 60603-3406 | | | 2123 | |

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/870,119 | EHRLICH ET AL. |
| Examiner | Art Unit | |
| Dwin M Craig | 2123 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 May 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 May 2001 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

1. Claims 1-34 have been presented for Examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-34 are rejected under 35 U.S.C. 101 for being directed towards non-statutory subject matter.

2.1 Applicants claimed invention is directed to non-statutory subject matter.

Specifically and using independent **Claims 6 & 7** as examples, the claims do not appear to claim a tangible or useful result, specifically in the cited example claims, the claim language discloses mathematical enumeration of construction elements in a building design and does not solve any problem regarding the design of a building. Clarification and amendment are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by **Narikawa et al. U.S. Patent 5,119,317.**

3.1 As regards independent **Claims 1, 6, 7, 10, 15, 16, 33 and 34** the *Narikawa et al.* reference discloses:

A method for evaluating a composite development plan the composite plan being indicative of a simultaneous arrangement of a first delivery system and a second delivery system in a building, the first and second delivery systems being composed of elements

(Figures 1, 15, 16 & 24, Col. 6 Lines 18-25, note, the divided areas as made clear in the cited section of the *Nakikawa et al.* reference are functionally equivalent to an arrangement of different delivery systems, where the delivery is a delivery of water, of gas or some other substance through a pipe.)

*(a) providing a standard, the standard specifying a first distance; and
(b) for each pair of a first element present in the first system and a second element present in the second system determining whether the distance between first and second elements in the composite plan, is greater than the first distance.*

(Figures 20, 22A, specifically when optimal routes are calculated it is inherent that there will be a first distance and a second distance, as different segments of pipe are added to the design. **Col. 10 lines 66-68, Col. 11 Lines 1-29).**

3.2 As regards dependent **Claims 2-5 and 11-14** the *Nakikawa et al.* reference discloses different elements and distances between those elements (**Figure 2**).

3.3 As regards dependent **Claims 17-32** the *Nakikawa et al.* reference discloses a data processing system (**Figure 21**).

4. **Claims 1-34** are rejected under 35 U.S.C. 102(b) as being anticipated by *Shinoaki et al.* U.S. Patent 5,592,397.

4.1 As regards Independent **Claims 1, 6, 7, 10, 15, 16, 33 and 34** the *Shinoaki et al.* reference discloses:

A method for arranging n delivery systems in a building the method comprising the steps of: (Figure 1, the nodes show that there will be “n” delivery systems).

Providing a developmental plan for each of n systems (Figures 8 & 9).

Arranging the systems in a hierarchy, S₁.....S_k.....S_n where there is kth hierarchy. (Figure 11B item 100 NODE LEVEL(i)).

As regards the formula's as disclosed in the rest of Claims 6 & 7, Shinoaki et al. teaches (Figures 15, 18 & 19).

4.2 As regards dependent **Claims 2-5 and 11-14** the *Shinoaki et al.* reference discloses different elements and distances between those elements (**Figures 1-7**).

4.3 As regards dependent **Claims 17-32** the *Shinoaki et al.* reference discloses a data processing system (**Figure 9**).

Conclusion

5. **Claims 1-34** have been presented for Examination. **Claims 1-34** have been Examined and rejected. This Office Action is **Non-Final**.

5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

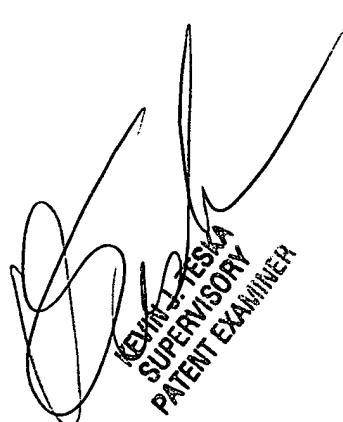
- U.S. Patent 5,556,537 teaches a hierarchical system of composite resource planning in a building design (**Figures 1-21**).
- U.S. Patent 5,517,428 teaches a hierarchical system of composite resource planning in a building design (**Figures 1-7**).

5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is (571) 272-3710. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (571)272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-308-1396.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER